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09/238,502	01/27/1999	YOSHIKAZU KOBAYASHI	Q52863	6211

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SUGHRUE MION ZINN MACPEAK AND SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037

EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2644

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/238,502	Applicant(s) KOBAYASHI, YOSHIKAZU	
	Examiner Walter F. Briney III	Art Unit 2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-15 and 18-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the PrimaSoft Dialer version 1.4 (Copyright 1995, 96 by PrimaSoft PC, Inc.).**

Claim 1 is limited to *a telephone call dialing method, for use in an information terminal with an operating system which can display a plurality of windows*. PrimaSoft developed a programmed named Dialer, copyright 1995, 96, for use with Windows 3.1/95, a GUI layered on top of the MS-DOS operating system. Windows 3.1/95 enabled multiple windows of information to be stacked and arranged on a single monitor, enabling multiple simultaneous data views. The PrimaSoft Dialer enables a user to enter a telephone string into a "Number to Dial" box and by actuating a Dial button, automatically dial said telephone string. The PrimaSoft Dialer function window is shown in figure 2. Figure 5 depicts a dialing function, figure 6 depicts a call completion function, and figure 7 depicts a call connection function. While the core features of the Dialer are clear from figures 2 and 5-8, there is no indication as to how telephone numbers are entered. Therefore, the PrimaSoft Dialer anticipates all limitations of the claim with the exception wherein *a string of character information in a*

window displayed by the operating system is selected, stored, extracted and subsequently dialed.

The examiner takes Official Notice of the fact that it was well known at the time of the invention to copy-and-paste information from one window displayed by the Windows 3.1/95 GUI (OS) to another window. The notoriously well-known copy-and-paste feature was known to simplify data entry on information terminals by reducing the number of repetitive keystrokes necessary to transfer character strings between applications. In a conventional non-windows environment, text strings are copied manually, such as remembering the string and entering each character of said string one character at a time with the keyboard. The copy-and-paste eliminates the overhead of remembering the string, by allowing text (i.e. *string of character information*) to be *selected* from one *window* as seen in figure 3 and *stored* in the *OS memory* by the copy action. The *selection* and *storing* functions described above correspond to collecting data from a first window, or *a first operation* as claimed. Furthermore, the stored string is pasted into the target window as shown in figure 4, the result shown in figure 5. The dial operation subsequently *extracts* and *dials* the digit information presented in the "Number To Dial" box of figure 5, essentially ignoring any punctuation used for formatting. The pasting, *extraction* and *dialing* described above correspond to initiating dialing using the collected data from the first window, or *a second operation* as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to copy-and-paste a telephone number in a first window to the PrimaSoft Dialer displayed in a second window as was known in the prior art for the purpose of

reducing the overhead involved in manually transferring character-by-character a telephone number in the first window to the second window.

Claim 2 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. In accordance with the copy-and-paste feature, the selected dialing string is inherently stored in the common working memory shared by the *operating system*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 3 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. In accordance with the copy-and-paste feature, a dialing string is selected using either mouse or keyboard highlighting features, such as click-and-drag or by holding down the shift and arrow keys simultaneously, and the selection is carried out through a regional designation before being copied to memory, or *stored*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 4 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. Inherently, a telephone number does not include symbols such as parenthesis, dashes or white space as seen in figure 5. Therefore, these extraneous formatting characters are essentially deleted from the outgoing dial string; i.e. *extracting includes deleting information except for that relevant to numerals from the selected string of character information, the telephone number is extracted from the resulting remainder*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 24 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. As described in the rejections of claims 1 and 3, the copy function depicted in figure 3 requires the dialing string to be selected by highlighting the string in the Notepad window, or *regional designation*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 25 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. The paste and dial functions depicted in figures 4 and 5 are shown using the mouse, where the right-mouse button is clicked to bring up the OS function menu, including the paste option, the left-mouse button is clicked to actuate the paste function, and the left-mouse button is pressed to actuate the Dial button; i.e. *wherein said second operation is pressing one or more buttons of a pointing device*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 26 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. Although explained in the rejection of claim 25 using the mouse as the exemplary input device, the possibility of using keyboard shortcuts is also shown in figures 4 and 5. In particular, the paste function can be actuated by striking the "P" key on the keyboard, and the dial function can be actuated by striking the "D" key on the keyboard; i.e. *wherein said second operation is pressing one or more keys of a keyboard*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 27 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. Clearly, the notepad depicted in figure 3, from which

the dialing string is copied, has no relation to the PrimaSoft dialer and contains no abilities but to enter text; i.e. *wherein said window is associated with an application unrelated to call-dialing*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 28 is limited to *the telephone call dialing method according to claim 27*, as covered by the PrimaSoft Dialer. The Notepad application depicted in figure 3, from which the dialing string is copied, is clearly a *word processor*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 5 is limited to *a telephone call dialing method, for use in an information terminal with an operating system which can display a plurality of windows*. For the same reasons as those presented above with respect to claim 1, it would have been obvious to perform a copy-and-paste operation with the PrimaSoft Dialer to simplify the operation of the Dialer.

With respect to the precise method steps claimed, the Dialer, in a first step, displays the window shown in figure 2. A user performs a copy, or *first operation*, that includes *selecting* a dialing string (i.e. *a string of character information*) from a Notepad document displayed in a *second window*. The user then actuates the copy function as seen in figure 3, resulting in the selected string being *stored* to the shared OS memory. To dial the number copied, the user simply pastes by way of the method depicted in figure 4, the pasting being associated with the general step of *extracting* under the *second operation* as claimed. Then, the user must perform a *third operation* that involves clicking on the dial button as seen in figure 5 to initiate *dialing a call to a line*

based upon the extracted telephone number. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 6 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As seen in figure 4-8, the operating system displays multiple overlapped windows, the PrimaSoft Dialer being arranged on top when it is the “active” window as is inherent with all Windows 3.1/95 systems. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 7 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. Clearly, the PrimaSoft Dialer window is in the form of a *toolbar*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 8 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As seen in figure 8, a list of recently dialed numbers is presented to a user of the PrimaSoft Dialer by clicking on a down arrow next to the “Number To Dial” box. This arrow and the Dial key correspond to *call dialing keys* within a *telephone region*. The user simply clicks the down arrow, *selects* a recently dialed number, depresses the Dial key and the system parses (i.e. *detects*) the number in the “Number To Dial” box and *call-dials* it as shown in figures 5-7. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 9 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As seen in figure 8, a list of recently dialed numbers is presented to a user of the PrimaSoft Dialer by clicking on a down arrow next to the “Number To Dial” box. This arrow corresponds to a *call log region*. The user simply

clicks the down arrow, *selects* a recently dialed number, depresses the Dial key and the system parses (i.e. *detects*) the number in the "Number To Dial" box and *call-dials* it as shown in figures 5-7. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 29 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As described in the rejections of claims 1 and 3, the copy function depicted in figure 3 requires the dialing string to be selected by highlighting the string in the Notepad window, or *regional designation of the second window*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 30 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. The paste and dial functions depicted in figures 4 and 5 are shown using the mouse, where the right-mouse button is clicked to bring up the OS function menu, including the paste option, and the left-mouse button is clicked to actuate the paste function; i.e. *wherein said second operation is pressing one or more buttons of a pointing device*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 31 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. Although explained in the rejection of claim 25 using the mouse as the exemplary input device, the possibility of using keyboard shortcuts is also shown in figures 4 and 5. In particular, the paste function can be actuated by striking the "P" key on the keyboard; i.e. *wherein said second operation is pressing one*

or more keys of a keyboard. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 32 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. After pasting the number from memory, it is dialed by actuating the Dial button using, for example, the mouse as seen in figure 5; i.e. *wherein said third operation includes pressing a button displayed in the first window.* Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 33 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. The Dial button is essentially an *extension button* when used to dial an *internal number*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 34 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. The Dial button is essentially a *line wire button* when used to dial an *external number*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 35 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. Clearly, the PrimaSoft Dialer comprises the *first application and first window* as claimed, and is related to *call-dialing*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 36 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. Clearly, the Notepad depicted in figure 3, from which the dialing string is copied, has no relation to the PrimaSoft dialer and contains no

abilities but to enter text; i.e. *wherein said window is associated with an application unrelated to call-dialing*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 37 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. The Notepad application depicted in figure 3, from which the dialing string is copied, is clearly a *word processor*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 10 is limited to *an information terminal, with an operating system which can display a plurality of windows*. The terminal claimed simply consists of means that are inherently required to fulfill the method steps of claim 1, whose inherent means and method steps have been shown to be obvious in view of the PrimaSoft Dialer. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 12 is limited to *the information terminal according to claim 10*, as covered by the PrimaSoft Dialer. While not explicitly shown, it is known that the PrimaSoft Dialer only serves to interface between the user and the underlying telephony application programming interface (TAPI) that is truly responsible for dialing from the *information terminal* using a modem, the TAPI and modem correspond to *call dialing control means*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 14 is limited to *the information terminal according to claim 10*, as covered by the PrimaSoft Dialer. As shown in the rejection of claim 4, the extraction means, during the extraction step, removes all non-numeral strings before dialing. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claims 38-40 recited essentially the same subject matter as claims 24-26, as covered by the PrimaSoft Dialer. As such, the PrimaSoft Dialer makes obvious all limitations of the claims.

Claim 11 is limited to *an information terminal, with an operating system which can display a plurality of windows*. The terminal claimed simply consists of means that are inherently required to fulfill the method steps of claim 36, whose inherent means and method steps have been shown to be obvious in view of the PrimaSoft Dialer. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 13 is limited to *the information terminal according to claim 11*, as covered by the PrimaSoft Dialer. As seen in figure 5, the pasted (i.e. *extracted*) *telephone number* is displayed in the *first window*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claims 15 and 21 recite essentially the same subject matter as claims 6 and 7, as covered by the PrimaSoft Dialer, respectively. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claims.

Claim 18 is limited to *the information terminal according to claim 11*, as covered by the PrimaSoft Dialer. The *first window* displayed in figure 2 is rendered inactive and placed underneath an active Notepad window as seen in figure 3. This enables the use to copy a telephone number from the Notepad. The *inactive signal* corresponds to, for example, the user's mouse click within the Notepad window. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 19 is limited to *the information terminal according to claim 18*, as covered by the PrimaSoft Dialer. Clearly, the inactive signal simply changes the visual arrangement of displayed windows, but does not initiate *extraction*. This is only performed by the paste function as seen in figure 4. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 20 is limited to *the information terminal according to claim 11*, as covered by the PrimaSoft Dialer. Simply initiating and displaying the *first window* (i.e. *setting the first window to a tool bar display form*) as it is shown in figure 2 does not result in an *extraction*. Again, *extraction* only occurs responsive to the paste function shown in figure 4. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 41 and 42 are limited to *the information terminal according to claim 11*, as covered by the PrimaSoft Dialer. As shown in the rejections of claims 29 and 37, the dialing string is selected through *regional designation* from a Notepad (i.e. *second window/second application/word processor*). Therefore, the PrimaSoft Dialer makes obvious all limitations of the claims.

Claims 22 and 23 are limited to *computer-readable recording mediums, storing programs to be executed by computers*. The programs claimed therein recite essentially the same steps as those of method claims 1 and 5, as covered by the PrimaSoft Dialer, respectively. As the Dialer is in fact a program, the PrimaSoft Dialer makes obvious all limitations of the claims.

Claims 43-47 recite essentially the same subject matter as claims 29-31, 36 and 37, as covered by the PrimaSoft Dialer, respectively. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claims.

2. **Claims 11, 16 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Contact Book version 4.4 (Copyright 1994, 97, by PrimaSoft PC, Inc.)**.

Claim 11 is limited to *an information terminal, with an operating system which can display a plurality of windows*. Similar to the PrimaSoft Dialer discussed above, PrimaSoft also released a program known as Contact Book for use with the Windows 3.1/95 GUI interfaces for use with the MS-DOS operating system. For the same reasons presented above, it would have been obvious to copy-and-paste numbers to simplify the manual dialing operation provided by the Contact Book. Figure 3 provides a call window for use in a manner analogous to that described above with respect to the Dialer. Also, as seen in figures 4-8, a number is advantageously copied (i.e. *selected and stored*) from a second window and pasted (i.e. *extracted*) into the Contact Book call window and *dialed*. Each program element responsible for implementing the above described steps corresponds to the respective *means* claimed. Therefore, the Contact Book makes obvious all limitations of the claim.

Claim 16 is limited to *the information terminal according to claim 11*, as covered by the PrimaSoft Contact Book. Specifically shown in figure 7 is that predetermined prefixes can be affixed to the *extracted* telephone number that results from the paste function depicted in figure 6. Because this added number is dialed along with the *extracted number*, it follows that *the output means adds a given number to the top of the*

extracted telephone number, and outputs the extracted telephone number with the given number. Therefore, the Contact Book makes obvious all limitations of the claim.

Claim 17 is limited to *the information terminal according to claim 11*, as covered by the PrimaSoft Contact Book. Clearly seen in figure 7 is that the added number, or given number, is displayed after actuating the "Use" button; i.e. *wherein the display application means attaches a given character string to the extracted telephone number, and controls said display to display the extracted telephone number with the given character string.* Therefore, the Contact Book makes obvious all limitations of the claim.

Response to Arguments

Applicant's arguments filed 10 December 2004 with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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